

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-8 are now present in this application. Claims 1 and 3 are independent.

Claims 1-3, 6 and 7 have been amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

The Examiner has not acknowledged Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document. Acknowledgment thereof by the Examiner in the next Office Action is respectfully requested.

Information Disclosure Citation

Applicant thanks the Examiner for considering the references supplied with the Information Disclosure Statements filed on January 27, 2005 and July 30, 2006, and for providing Applicant with an initialed copy of each PTO/SB/08 form filed therewith.

Obviousness-Type Double Patenting Provisional Rejection

Claims 1-3 and 6-8 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 10-12 of U.S. Patent Application No. 10/748,297. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, Applicant is herewith submitting a Terminal Disclaimer disclaiming the terminal portion of any patent granted on the present application

which would extend beyond the expiration of any patent which issues from U.S. Application No. 10/748,297.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1, 2 and 6-8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,430,768 to Novinger. This rejection is respectfully traversed.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent.

Applicant respectfully submits that the PTO has failed to meet this burden.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 1 has been amended to recite a combination of features, including (1) an agitator roll having two ends rotatably installed inside the suction port, a plurality of brushes being arranged on the agitator roll in the length direction; and (2) an agitator driving unit connected to the outer roller surface of the agitator roll located between, and separate from, the two ends for driving the agitator roll to perform reciprocating rotation in a predetermined angle range.

Novinger does not disclose this combination of features. For example, Novinger's pulley 3 is connected to a roller protrusion 2 extending from the end of the agitator roll 6 (see Fig. 1, for example).

With regard to dependent claims 2 and 6-8, Applicants submit that claims 2 and 6-8 depend from independent claim 1, which is allowable for the reasons set forth above, and therefore claims 2 and 6-8 are allowable based on their dependence from claim 1.

Reconsideration and allowance of claims 1, 2 and 6-8 are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Novinger in view of U.S. Patent 4,020,536 to Johansson. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole", not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the Examiner must explain what the differences between the claimed invention and the prior art are and provide objective factual evidence to support a conclusion that it would be obvious to one of ordinary skill in the art to achieve the claimed invention, which includes those missing features.

In the second place, in rejecting claims under 35 U.S.C. §103, it is incumbent on the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is

expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

The Office Action admits that Novinger does not disclose a rotary link fixed to the motor shaft.

In an attempt to remedy this admitted deficiency, the Office Action turns to Johansson. The Office Action asserts that the patent to Johansson shows a direct connection between the rotary link 18, 19 and the motor shaft, referencing col. 2, lines 5-10 of Johansson. Based on this assertion, the Office Action asserts that it would be obvious to substitute Johansson's art-recognized equivalent direct drive mechanism for Novinger's indirect drive mechanism to render the claimed invention obvious.

Applicant respectfully disagrees for a number of reasons.

Firstly, Johansson does not explicitly disclose a direct-drive mechanism of a rotary link fixed to a motor shaft of the driving motor and rotated coaxially to the motor shaft, as claimed. Johansson never shows how his motor, which is clearly not shown in the single figure of Johansson, is connected to disc 18, and only discloses, in col. 2, lines 1-23, that "... the disc rotates about its center by means of an electric motor (not shown) in the direction shown by arrow A in the FIGURE."

This is clearly not an explicit disclosure that disc 18 is fixed to a motor shaft of the driving motor and rotated coaxially to the motor shaft, as recited. Nor is it an inherent disclosure of the claimed invention, which requires that the claimed feature is not just possibly disclosed by Johansson, nor even probably disclosed by Johansson, but must necessarily be disclosed by Johansson.

Accordingly, even if one of ordinary skill in the art were properly motivated to modify Novinger in view of Johansson, the Office Action fails to present objective factual evidence that the modified version of Novinger would render obvious the claimed invention, or a *prima facie* case of the obviousness of the claimed invention.

Secondly, the Office Action fails to provide a *prima facie* case of proper motivation for one of ordinary skill in the art to modify Novinger's drive mechanism in any way in view of Johansson's failure to disclose any details whatsoever of how its motor is connected to disc 18.

Thirdly, neither Novinger nor Johansson discloses or suggests a hinge bracket fixed to one side of the outer circumference of the agitator, as positively recited in independent claim 3. Because neither applied reference provides such a feature, the Office Action fails to provide any objective evidenced that such a feature would be obvious to provide in Novinger, as modified by Johansson.

Thus, the Office Action fails to provide a *prima facie* case of obviousness of the invention recited in claims 3-5.

Reconsideration and withdrawal of this rejection of claims 3-5 are respectfully requested.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requestd that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

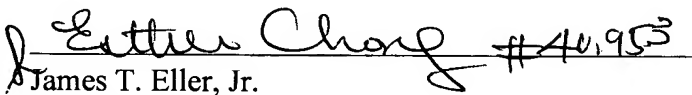
Application No.: 10/748,295
Art Unit 1744

Attorney Docket No. 0630-1901P
Reply to September 27, 2006 Office Action
Page 11

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:  #40,953
James T. Eller, Jr.
Reg. No.: 39,538

JTE/RJW/kj 

P.O. Box 747
Falls Church, Virginia
22040-0747
Telephone: (703) 205-8000

Enclosure: Terminal Disclaimer